REMARKS

Summary of the Office Action

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,573,625 to Olesen et al. ("Olesen") in view of U.S. Patent No. 6,923,360 to Sesek et al. ("Sesek").

Summary of the Response to the Office Action

Claims 1-4 and 7-12 are presently pending for further consideration. New claim 12 has been added.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olesen in view of Sesek. Applicants respectfully traverse the rejection. of the claims.

There is nothing in Olesen that can be considered a fixed anvil as recited in claim 1. To repeat the arguments of the amendment of November 27, 2007:

It is clear from Fig. 9 that only block 60 (alleged in the Office Action to be the moveable anvil of claim 1) is in the path of driver blade 80 and/or former 70 such that it can be considered an anvil. However, block 60 cannot be both a moveable anvil and a fixed anvil. Similarly, Fig. 19 only shows block 60' in the path of driver blade 80' and/or former 70' such that it can be considered an anvil. Cartridge extensions 508 appear in the section view of Fig. 19 to be in the path of driver blade 80' and/or former 70', but Fig. 17 clearly shows cartridge extensions 508 to be above and outside of the width of the staple blanks. Thus, cartridge extensions 508 cannot be considered an anvil – fixed or moveable. Thus, Olesen does not disclose or suggest the fixed anvil recited in claim 1.

Sesek also does not disclose a fixed anvil as recited in claim 1. Element 110 of Sesek may be considered analogous to an anvil for forming staples from staple blanks. However, as described, e.g., at col. 5, lines 27-58 of Sesek, the forming anvil first member 112 and second member 132 move toward or away from one another. This is the gist of the invention, moving the anvil members to adjust the

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length of the legs of the staples. Thus, there is nothing in Sesek that can be considered the fixed anvil recited in claim 1.

Applicants respectfully assert that – absent a fixed anvil as recited in claim 1 – Olesen cannot be modified so that the forming plate is "capable of forming the staple member which is arranged above the movable anvil advanced into the striking path and the staple member which is successive to the staple member above the movable anvil simultaneously in the C-shape" as also recited in claim 1. If Olesen were modified to make the former wide enough to form two staples at once and there were no fixed anvil, there would be nothing to keep the second staple blank from breaking off as the former came down. If the groove 64 in the former block 60 of Olesen were made deeper to accommodate two staples, the driver blade 80 could either be wide enough to accommodate two staples – in which case it would drive two staples at once into the stacks of paper – or the driver blade could remain at the present width so that one staple would remain permanently in groove 64. In either case, the stapler would not operate properly.

The Office Action of February 11, 2008 states that "claim 1 merely discloses a 'fixed anvil' and it is examiner's position that Olesen' (*sic*) extensions 508 read on the claimed fixed anvil, i.e. a structure formed at a front end of the staple guide for guiding the connected staples to the striking portion as described in applicant (*sic*) specification." The Office Action totally ignores the fact that the fixed anvil recited in claim 1 is first and foremost an <u>anvil</u>.

The Applicant rather than the Examiner is the one given the freedom to be his or her own lexicographer. The Office Action cannot simply decree that an element in the prior art is the feature recited in the claims, ignoring the plain meaning of the words of the claim. Per MPEP § 2111.01, "the words of the claim must be given their plain meaning unless... the plain meaning is inconsistent with... the specification." An anvil is "a heavy block... on which metals are shaped by hammering." (THE AMERICAN HERITAGE COLLEGE DICTIONARY, 3d ed. (2000).) This is exactly how the term "anvil" is used in the specification of the present invention. This

meaning is reinforced by claim 8, which states that "the staple member is formed in the C-shape on the fixed anvil." Extensions 508 of Olesen are clearly not an anvil as recited in claim 1 (and especially claim 8) because no metal is shaped on extensions 508. Further, it is impossible for the extensions 508 of Olesen to be used as an anvil for forming a staple member into the C-shape as recited in claim 8.

The Office Action of February 11, 2008 continues to cite *In re Hutchison* for the proposition that "recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform [and] does not constitute a limitation in any patentable sense." Because there appears to be some confusion about what *In re Hutchison* says, a copy is enclosed for the benefit of the Examiner. Although the phrase "capable of" with reference to elements of an apparatus appears multiple times in the claims, those phrases are never discussed. Instead, the case involves the intended use of the apparatus being claimed as expressed in introductory clauses. The intended uses of the present invention or the cited art have never been discussed in any Office Action or response. Thus, Applicants respectfully request that – if and until the intended use of the present invention or cited art become an issue – that all reference to *In re Hutchison* cease. It is simply not material to prosecution of the present invention.

The Office Action of December 12, 2007 further states with respect to claims 1 and 7-8, that "the functional language is no (*sic*) supported by sufficient structure to perform the forming of two staples simultaneously." If this statement is intended to be a rejection, Applicant is unaware of the basis. In any event, the structure is described in great detail in the specification, so there should be no issue with enablement.

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In discussing the failure of Olesen to disclose or suggest the ability to form two staples at once, the Office Action of December 12, 2007 states that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." First, the ability to form two staples at once is not an "intended use," but only describes the structure of the claimed invention in functional terms (Examiner is asked again to review MPEP §2173.05(g), which explains that "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the art in the context in which it is used." (emphasis added).). Second, as explained above in the repetition of the arguments from the Amendment of November 27, 2007, Olesen is not "capable of forming the staple member which is arranged above the movable anvil advanced into the striking path and the staple member which is successive to the staple member above the movable anvil simultaneously in the C-shape" as recited in claim 1. Thus, the quote from the Office Action of December 12, 2007 is meaningless as applied to the Olesen reference.

Similarly to the Office Action of December 12, 2007, the Office Action of February 11, 2008 – in discussing the feature of the forming plate – states that "a reference is deemed to anticipate a claim when all the recited structural limitations are disclosed in the prior art." First, the Examiner is no longer even asserting that Olesen anticipates the present invention. Second, Olesen does not recite the forming plate as recited in claim 1. Thus, this quote from the Office Action of February 11, 2008 is also immaterial.

For at least the foregoing reasons, Applicants respectfully assert that claim 1, and its dependent claims 2-4 and 7-11 are in condition for allowance.

New independent claim 12 has been added. Applicants respectfully assert that claim 12 is

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in condition for allowance.

Prompt allowance of claims 1-12 is requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely

allowance of the pending claims. Should the Examiner feel that there are any issues outstanding

after consideration of this response, the Examiner is invited to contact Applicants' undersigned

representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge

the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under

37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also

be charged to our Deposit Account.

Respectfully submitted,

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C

Court of Customs and Patent Appeals.
Application of HUTCHISON.
Patent Appeal No. 5123.

March 6, 1946.

Appeal from the Board of Patent Appeals of United States Patent Office, Serial No. 416,334.

Proceedings in the matter of the application of Miller Reese Hutchison for a patent on the process of immunizing hygroscopic sheet material against dimensional variations and on the product thereof. From a decision of the Board of Appeals affirming decisions of primary examiners in rejecting certain product claims, the applicant appeals.

Affirmed.

West Headnotes

[1] Patents 113(6) 291k113(6) Most Cited Cases (Formerly 291k13(6))

Court of Customs and Patent Appeals is not concerned with claims allowed, but will consider only whether claims which were disallowed were properly rejected.

[2] Patents 101(3) 291k101(3) Most Cited Cases (Formerly 291k101)

Statement in introductory clause of claim in application that laminated article sought to be patented is "adapted" for use in making a template, or the like, did not constitute a limitation in a patentable sense.

[3] Patents 66(1.25) 291k66(1.25) Most Cited Cases (Formerly 291k66(1))

Claims for an article of manufacture comprising a sheet of metal to which a sheet of drawing paper or a layer of photographic emulsion is secured by means of a heat-settable waterproof adhesive which is heat-resistant, which article may be machined to form a template, held not patentable over prior art.

Patents 328
291k328 Most Cited Cases
2,000,528. Cust. & Pat.App. Cited as a reference.

Patents 528

291k328 Most Cited Cases 2,311,547. Cust. & Pat.App. Cited.

**135 *879 Morrison, Kennedy & Campbell, of New York City (Luther E. Morrison, of New York City, and Edmund H. Parry, Jr., of Washington, D.C., of counsel), for appellant.

W. W. Cochran, of Washington, D.C., (E. L. Reynolds, of Washington, D.C., of counsel), for the Commissioner of Patents.

Before GARRETT, Presiding Judge, and BLAND, HATFIELD, JACKSON, and O'CONNELL, Associate Judges.

GARRETT, Presiding Judge.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office affirming decisions of primary examiners rejecting certain product claims of appellant's application, serial No. 416,334, filed October 24, 1941, relating, as recited in the specification, 'to a process for immunizing hygroscopic sheet materials against dimensional variations and to the product thereof.'

As hereinafter more fully explained, the claims here involved are directed to the particular kind of laminated material from which templates-*880 that is gauges or patterns for use as guides in forming the desired finished article-may be made.

The claimed invention was described in the decision of the board as follows:

It is disclosed that applicant proposes to immunize hygroscopic sheet material, such as ordinary drawing paper and the like, against dimensional variations resulting from changes in atmospheric moisture by adhering them to backing elements which themselves are immune to such changes, for example, metal or glass. It is disclosed that a water-proof thermoplastic is used as an adhesive to effect a bond between the sheet material and the backing element. Claim 42, for example, calls for an article of manufacture as a laminated unit comprising **136 a backing element surfaced with paper having an exposed outer surface to receive the design and composed of metal stock of requisite thickness and rigidity to become the finished template and capable of being machined, the surfacing

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paper bonded to the metal backing element by a water-proof heat-set and heat-resistance adhesive.'

We also quote the following from the brief of the Solicitor for the Patent Office:

This material comprises a sheet of metal to which a sheet of drawing paper or a layer of photographic emulsion is secured by means of a heat-settable water-proof adhesive. Since it is intended that this composite sheet shall be machined to form a template, the adhesive selected must, of course, be one which will not soften at the temperature produced by machining. The fact that the paper is uniformly secured to the metal prevents distortion or change in size of the paper due to changes in moisture content, and thus preserves the dimensions of figures on the drawing paper or photographic layer.'

Five process and nine product claims stand allowed.

There are six claims (all for the product) on appeal. They are numbered, respectively, 42, 43, 54, 56, 57, and 58.

It appears that because of certain differences in the claims involved in the application procedure was had in the Patent Office under what is described in the statement of one of the examiners as the 'Dual Prosecution Practice,' claim 58 (as were the allowed claims) being passed upon by an examiner in Division 7, which division had general jurisdiction of the application, while the other claims were passed upon by an examiner in Division 55. We understand from statements made during the oral arguments before us that the 'Dual Prosecution Practice' was instituted comparatively recently. This is the first case of that character to come before us. The practice itself is immaterial to any issue here presented. The board, of course, had before it statements of two examiners, but each was confined to the particular claims before the different divisions. The references cited by both examiners were the same, and we may say that whatever may have been the situation with respect to the allowed claims, so far as we can discern, appealed claim 58 might very well have been considered in the same division where the other appealed claims were passed upon.

*881 The application as filed recited that it was a division of a co-pending application, 402,128, filed July 12, 1941, and, by an amendment entered July 16, 1943, it was stated that the parent application 'matured into patent No. 2,311,547, dated February 16, 1943.' Appellant's brief refers to the patent a number of times,

but no copy of it was included in the record certified to us and we find no reference to it, or to the parent application, in any of the decisions of the tribunals of the Patent Office, nor in the reasons of appeal. The brief of the Solicitor for the Patent Office states that it 'apparently involves a method of making templates from laminated material, while the claims here involved are directed to the laminated material from which the templates are made.' It seems to be the position of appellant that the here involved claims should be allowed 'to supplement the protection afforded' by the issued patent.

It may be said that in the brief for appellant it is stated, in substance, that the laminated material for which patent is sought, 'While capable of more general application,' is particularly designed for the manufacture of templates used in the mass production of airplane parts, and the brief describes in considerable detail the matter of riveting the fuselage and wings of aluminum alloy sheets to each other and to the frame. It is said 'The rivets must freely pass through holes in the sheets, which attach to other sheets and to the frame, requiring that the holes be drilled with great care and accuracy.' This, of course, is a general statement of a specific necessity in the manufacture of modern airplanes, and appellant asserts that the laminated material described in his specification when used in templates renders them immune from fluctuation or variation in dimension (which sometimes must be accurate to 'a thousandth of an inch') by reason of temperatures, atmospheric moisture and other conditions which affect metal and paper.

Neither the specification nor the claims of the application mention airplanes. Much of the specification defines method but the product is also defined.

As has been stated, appellant has been allowed in this divisional application five process claims and nine product claims. Apparently (we accept the statements in **137 the briefs before us) he was also allowed method claims in the patent based upon the parent application.

[1] We are not concerned, of course, with the allowed claims in either the patent or in this application. The sole question for our determination is whether the six article claims on appeal were properly rejected below, and this we pass upon without further reference to, and without comparing them with, the claims of the patent or the claims which stand allowed in this application.

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*882 The board quoted claim 42 (prosecuted in Division 55) as 'an example' of all the claims. It paraphrased claim 58 (prosecuted in Division 7) but did not quote the text.

We here quote both (and in quoting them follow the italicization used by appellant in his brief to indicate the limitations which he insists render the claims patentable):

42. As an article of manufacture, adapted for use in the fabrication of a metal template or the like suitable for metal-working operations, a laminated unit comprising a backing element surfaced with paper having an exposed outer surface to receive the template design, said backing element being composed of metal stock possessing the requisite thickness and rigidity to become the finished template and capable of being machined under heat generating conditions in accordance with the template design, and said surfacing paper being bonded to the metal backing element by a water-proof heat-set and heat-resistant adhesive which renders the paper immune from plane dimensional variations resulting from changes in atmospheric moisture, and said adhesive being set under temperature and time conditions which produce a bond between the surfacing paper and the metal backing element that is unaffected by the heat generated during said template machining operations, the heat-resistant temperature of the heat-set adhesive being well above 212 degrees F.

'58. As an article of manufacture, adapted to be adhered to a metal backing element for use in the fabrication of a template or the like suitable for metal-working operations, which metal backing element possesses the requisite thickness and rigidity to become the finished template and which is capable of being machined under heat generating conditions in accordance with the template design produced thereon after the adherence of the article, a flexible sheet material having one surface coated with an unexposed light-sensitive photographic emulsion for the printing of the template design and the opposite surface coated with a water-proof heat-setting and heat-resistant adhesive which, once set, renders the material immune from plane dimensional variations resulting from changes in atmospheric moisture, the temperature and time conditions required for the setting of the adhesive being such that, when the sheet material is bonded to the metal backing element, said bond will be unaffected either by the solutions used in the processing of the photographic emulsion after the printing exposure or by the heat generated during said

template machining operations, the heat-resistant temperature of the heat-set adhesive being well above 212 degrees F.'

In the introductory clause of claim 43 it is stated that the article is adapted for use in a photographic process (a feature present in other of the claims) and the claim also states that the thickness of the metal is 'many times the thickness of the drawing paper.' Claim 54 is drawn to a coated paper layer 'adapted to be adhered to a metal backing.' Claim 56 describes the metal as steel stock having a thickness of one sixteenth of an inch. No thickness is mentioned in the specification and the one sixteenth of an inch definition seems to have been inserted by amendment during the prosecution of the application. Claim 57 calls for photographic paper instead of drawing paper.

The examiner in Division 7 (which had general jurisdiction of the *883 application) in rejecting claim 58 cited the following patents as references:

Linderman, 2,000,528, May 7, 1935.

Rojas, 2,318,184, May 4, 1943.

Moxon (Br.), 197,051, May 10, 1923.

He applied a double rejection, that is 'on Linderman alone and also on Rojas or Moxon in view of Linderman.'

The examiner in Division 55, in rejecting the other claims, cited the same references.

He first discussed claim 42 and held it to be anticipated in the 'Rojas, Moxon and Linderman' patents, and, in substance, held the same with respect to claims 43, 54, 56, and 57.

The board followed generally the decisions of the respective examiners, but specifically **138 mentioned (although it did not overrule the others) only Linderman in affirming the examiner's rejection of claim 58.

In the brief for appellant the several claims are quoted, the limitations which his counsel regards as lending patentability to them being italicized, as in claims 42 and 58 quoted, supra, and each limitation is discussed, in connection with the teachings of the cited prior art. We have studied these with much care but we do not deem it necessary to set forth all the refinements embraced in appellant's arguments. The claims are similar to each other and obviously they stand or fall

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together. Each of them contains functional statements which may not be regarded as limiting the claims, they being article claims.

[2] Taking first claim 42 for analysis and comparing it principally with the Moxon patent, the first phraseology italicized by appellant is the introductory clause to the effect that the laminated article is 'adapted' for use in making a template or the like. This does not constitute a limitation in any patentable sense, but if it were in that category, it is anticipated by Moxon who teaches that his laminated sheet (made up of layers of paper and metal, united by an adhesive) may be used in making a template.

The second clause italicized is that relating to the composition of the backing element- metal stock-referring to its characteristics of thickness and rigidity. The Moxon patent discloses the use of a 'thin' metal sheet which 'may consist of an alloy of zinc and aluminum' to which 'the (drawing) paper may be affixed in close contact with the sheet by means of an appropriate adhesive such as a waterproof gum * * * .'

The third and fourth italicized clauses relate to the adhesive by which the paper is bonded to the metal backing, the manner of its setting, etc., to prevent variations resulting from changes in atmospheric *884 moisture and from heat generated during the template machining operations. No particular adhesive material is named.

[3] It seems obvious to us that all features of claim 42 are anticipated by the Moxon patent. Heat-set adhesives are admittedly old and the selection of one suitable for use in appellant's article would not involve invention. Machining necessarily generates heat and this would be present in Moxon.

The concluding part of the claim (a part common to all the appealed claims) refers to the heat resistant temperature of the heat-set adhesive as being well above 212 degrees F.' This is not mentioned in the specification and we find nothing to indicate that it is a critical element.

The limitations which appellant emphasizes in claims 43, 54, 56, and 57, while crouched in somewhat different phraseology, do not seem to differ in an patentable sense from those in claim 42.

The feature of photographic paper is definitely shown by Linderman, who also shows that the adhesive must be of a character resistant to the solutions used in the treatment. So far as the feature of 'steel stock' mentioned in claim 56 is concerned, it may be said that the specification does not define any particular metal, and the kind used would appear to be a matter of choice, and the 'thickness' feature described in the claim is not shown to be critical.

With respect to claim 58, quoted supra, it will be observed that, in the final analysis, it is specific only to photographic paper coated with adhesive, the metal plate (as is stated in the brief of the Solicitor for the Patent Office) being 'mentioned inferentially' and not positively included as an element.

We agree with the tribunals of the Patent Office that claim 58 fails to define invention over Linderman, particularly in view of the teachings of the other references.

Appellant has not convinced us that there was error in the rejection of the several appealed claims, and the decision of the board is affirmed.

*879 Affirmed.

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KEYCITE

CApplication of Hutchison, 33 C.C.P.A. 879, 154 F.2d 135, 69 U.S.P.Q. 138 (Cust. & Pat.App., Mar 06, 1946) (NO. 5123)

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<u>1</u> Metrologic Instruments, Inc. v. PSC Inc., 2003 WL 22077652, *37+ (D.N.J. Aug 26, 2003) (NO. CIV. 99-4876 (JBS)) "" HN: 2,3 (F.2d)

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Pat.App. Apr 08, 1965) (NO. 7351) (BNA Version)

Application of Allen, 343 F.2d 482, 485, 52 C.C.P.A. 1315, 1318, 145 U.S.P.Q. 147, 147 (Cust. & Pat.App. Apr 08, 1965) (NO. 7351) (BNA Version)

Administrative Decisions (U.S.A.)

Board of Patent Appeals and Interferences Decisions

- 3 EX PARTE KIRK D. PRALL, 2003 WL 25284313, *1+ (Bd.Pat.App. & Interf. Oct 22, 2003) (NO. APL 2003-1556, APP 09/288,932) "" ** HN: 2,3 (F.2d)
- 4 EX PARTE PETER J. BECKAGE, 2003 WL 25283985, *2 (Bd.Pat.App. & Interf. Apr 25, 2003) (NO. APL 2003-0242, APP 09/484,604) ** HN: 2 (F.2d)
- 5 EX PARTE RALPH B. BRICK, 2001 WL 1738852, *2 (Bd.Pat.App. & Interf. May 15, 2001) (NO. APL 2000-1794) ** HN: 2 (F.2d)
- 6 EX PARTE ROBERT-A. OLLAR, 1994 WL 1687107, *2 (Bd.Pat.App. & Interf. Jan 01, 1994) (NO. APPEAL 94-3182, APPLICATION 071899) ** HN: 2 (F.2d)

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- 7 How to Write a Patent Application s 6.6.5, Deficient Functional Language (2006) HN: 2 (F.2d)
- Landis on Mechanics of Patent Claim Drafting s 3:21, Functional or Operational Expressions (2006)
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- 9 ADVANCED CLAIM DRAFTING, 401 PLI/Pat 1, 5 (1994) HN: 2 (F.2d)

Court Documents Trial Court Documents (U.S.A.)

Trial Motions, Memoranda and Affidavits

- 10 AMGEN INC., Plaintiff, v. F. HOFFMANN-LA ROCHE LTD, Roche Diagnostics GMBH, and Hoffmann-La Roche Inc., Defendants., 2007 WL 3284158, *3284158 (Trial Motion, Memorandum and Affidavit) (D.Mass. Jun 22, 2007) Memorandum of Law in Support of Roche's Motion ... (NO. 05-CV-12237WGY) **
- TRI-WAY MACHINE LTD., Ontario, Plaintiff and Counter-Defendant, v. ALFING CORPORATION; and Alfing Kessler Sondermachinen GmbH, Defendants and Counter-Plaintiffs., 1998 WL 35176848, *35176848+ (Trial Motion, Memorandum and Affidavit) (E.D.Mich. Nov 16, 1998) Brief in Support of Tri-Way Machine Ltd.'s ... (NO. 97-7244) **